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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,854	09/23/2005	Toshifumi Mihashi	050592	7163
23850 7590 11/13/2008 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. Suite 400 WASHINGTON, DC 20005			EXAMINER DINH, JACK	
			ART UNIT 2873	PAPER NUMBER
			MAIL DATE 11/13/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/549,854

**Applicant(s)**

MIHASHI, TOSHIFUMI

**Examiner**

JACK DINH

**Art Unit**

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 27, 37, 42 and 48 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 and 42 is/are rejected.  
7) ☒ Claim(s) 27, 37 and 48 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 23 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20080922  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☒ Other: DETAILED ACTION

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai et al. (US Patent 6,761,454) in view of Nevyas et al. (US Patent 4,355,871).

Regarding claim 1, Lai (figure 3; col. 4, line 20 – col. 5, line 10) discloses a refraction measuring instrument comprising measuring means **32-40** that has a light source **24** for emitting a measurement light beam to an eye **15** to be examined and performs objective measurement on refraction of the eye to be examined based on reflection light of the measurement light beam emitted from the light source, which is reflected on the eye to be examined, and an optical system **20** to which the light source and the measuring means are added, for simultaneously guiding the measurement light beam emitted from the light source and visible light incident thereon from an outside to the eye to be examined, wherein the optical system comprises a beamsplitter **20** having a surface for combining the optical axis of the measurement light beam with the optical axis of the visible light by reflection of the measurement light beam and transmission of the visible light, wherein the light source emits the measurement light beam to be incident on the optical system from the direction different from that of the visible light,

wherein the beamsplitter reflects the incident measurement light beam so that the measurement light beam is incident on the eye to be examined, and reflects the reflection light from the eye to be examined inside itself to the direction different from that of the visible light, in order to output the reflection light to the measurement means, and wherein the measuring means measures the refraction of the eye to be examined while a subject is visually recognizing the outside through the visible light based on the reflection light of the measurement light beam which is guided to the eye to be examined through the optical system and reflected on the eye to be examined. Lai discloses all the claimed limitations except that the beamsplitter is a free-form surface prism. Within the same field of endeavor, Nevyas (col. 9, lines 23-37) discloses the teaching of another form of beamsplitter known to optical practitioners as the prism beamsplitter, or a free-form surface prism, which differs in appearance from the aforesaid types but which functions in similar fashion to them. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the free-form surface prism for design-choice purpose.

Regarding claim 42, Lai (figure 2) further discloses a wearing section (not referenced) for enabling the measuring means and the optical system to be worn on a head of the subject 15.

***Allowable Subject Matter***

2. Claims 27, 37 and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

Art Unit: 2873

limitations of the base claim and any intervening claims. Regarding claims 27, 37 and 48, the prior art fails to disclose a mark projection means, an imaging means, and a calculating means.

***Response to Arguments***

3. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. The Applicant amended claim 1 reciting the free-form surface prism but does not recite the deviation angle correcting prism recited in claim 22. Therefore, the Applicant's amendment necessitated new ground of rejection as presented above.

Rejection Under 35 USC 112

No argument provided.

Rejection Under 35 USC 102

No argument provided.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2873

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACK DINH whose telephone number is (571)272-2327. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jack Dinh/  
Examiner, Art Unit 2873  
11/06/08

Art Unit: 2873

/William C. Choi/

Primary Examiner, Art Unit 2873

11/10/2008